



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

EC

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,752	12/08/2000	Gaines W. Hammond	BSC-181	4800

21323 7590 07/22/2003

TESTA, HURWITZ & THIBEAULT, LLP
HIGH STREET TOWER
125 HIGH STREET
BOSTON, MA 02110

EXAMINER

PELLEGRINO, BRIAN E

ART UNIT	PAPER NUMBER
----------	--------------

3738

13

DATE MAILED: 07/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/733,752

Applicant(s)

HAMMOND ET AL.

Examiner

Brian E Pellegrino

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 and 16-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-15 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 10, 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Devonec et al. (5876417). Devonec et al. disclose (Fig. 7) a stent body member **8** with a lumen therein and a connecting segment **14** releasably coupled to the distal end of the tubular element **8**. It can be construed that the connecting segment also includes a distal end **25** that is located outside the body. Claims in a pending application are given their broadest reasonable interpretation, In re Hyatt, 211 F.3d 54 USPQ2d 1664 (Fed. Cir. 2000). In this instance it can be interpreted that the connecting segment is formed of multiple pieces, since the language in the claims is "comprising," which does not exclude multiple pieces. Devonec also discloses the tubular elements, which are connected together such that they are aligned to form the device form a single lumen, col. 2, lines 12-17.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 11,12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Devonec et al. '417 in view of Nissenkorn (4973301). Devonec is explained above. However, Devonec does not disclose the urethral device having a retaining member that is expandable at the proximal end of the urethral device. Nissenkorn teaches (Fig. 4) an expandable member at the proximal end of the prostatic device to hold the device within the bladder and prostatic section of the urethra. It would have been obvious to one of ordinary skill in the art to use a proximal retaining member as taught by Nissenkorn with the urethral device of Devonec et al. such that it does not get displaced during the surgical procedure.

Claims 11,12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Devonec et al. '417 in view of Mikus et al. (6033413). Devonec is explained supra. However, Devonec et al. do not disclose a retaining member at the proximal end of the urethral device. Mikus et al. teach (Fig. 7) a retaining member **14** that is expandable and located at the proximal end of the body member of the stent **7**. Mikus also teaches that the retaining member is pushed out via a pushing device, col. 5, lines 21-24. It would have been obvious to one of ordinary skill in the art to use a proximal retaining member as taught by Mikus et al. with the urethral device of Devonec et al. such that it does not get displaced during the surgical procedure.

Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Devonec et al. '417 in view of Mikus et al. '413 as applied to claim 12 above, and further in view of Klumb et al. (6238430). Devonec as modified by Mikus is explained as before. However, Devonec in view of Mikus do not disclose the use of a mechanism having a handle to control the pushing device. Klumb et al. teach (Fig. 1) a handle **10** with an opening **16** and a mechanism **14** attached to a pushing device that is received within the stent, col. 6, lines 2-7. It would have been obvious to one of ordinary skill in the art to use a controlled mechanism as taught by Klumb et al. with the urethral device of Devonec as modified by Mikus such that the pushing and delivering of the expandable component can be done in a controlled fashion without causing trauma to the patient.

Response to Arguments

Applicant's arguments with respect to claims 10 and 19 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3738

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Pellegrino whose telephone number is (703) 306-5899. The examiner can normally be reached on Monday-Thursday from 8:30am to 6pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2708. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Brian E. Pellegrino
TC 3700, AU 3738



Bruce Snow
Primary Examiner

20-July-03

